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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,442

Applicant(s)

WESTERMAN ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.



DETAILED ACTION

Claim Rejections - 35 USC § 101

1. Claims 1-15, 17-20 are rejected under 35 U.S.C. 101 because 35 U.S.C. 101

reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

■ Claims 12-15, 17, 19, 20 do not set forth a concrete, useful and tangible result. These claims appear to only require receipt of client information regarding a desire for auto service, however, no service is performed or even scheduled. Applicant should positively set forth scheduling and/or performance (if the system is capable of performance) of service based on the received data in order to achieve a concrete, useful and tangible result.

■ Claims 1-14, 17-20 are rejected under 35 U.S.C. 101 because they are not within the technological arts. See below

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created

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vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

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The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele

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test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, the body of the claims do not set forth at least one computer-based feature responsible for providing a non-trivial feature of the invention.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-17, 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 12, it is unclear if the system performs the actual scheduling or simply receives requested scheduling information.
- Claim 13 it is unclear if the system performs the selection of a provider or simply receives input requesting selection.

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- Claim 19, it is unclear what "coordinate the provision" of service requires.

Is this simply locating an eligible provider? Determine if provider will perform the service? Schedule the service?

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-6, 12, 13, 15, 16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirke (Employees snapping up array of volunteer benefits").

Applicant's claim language regarding the "incentive to enter a business relationship/employment benefit" I taken to provide mere functional language and intended use. There are no steps or features of the system claimed that require such a feature. Applicant's functional language regarding who is eligible to carry out the steps or who is eligible to use the system does limit the steps or system.

Regarding claims 1, 2, 6, 18, Kirke nonetheless teaches a business offering employees various benefits to help with recruitment, retention and morale. Kirke suggests offering a car repair pickup and delivery service. It would have been obvious to one of ordinary skill at the time of the invention to have received employee requests for service and to have scheduled car service appointments on behalf of the employee

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in order to save the employee time and frustration. The scheduled services are future repair services and each includes future car return service.

Regarding claim 4, as stated above, the steps of the claim are unpatentable over Kirke; the business relationship language is taken to be functional language. However, it would have been obvious to one of ordinary skill at the time of the invention to have offered such a service for any business relationship beyond employee-employer, such as a client entering into a parking contract with a parking contractor, as an additional perk for contract holders.

Regarding claim 5, 12, 13, 15, 16, 19, 20, it is well known to automate known manual processes and it would have been obvious to one of ordinary skill at the time of the invention to have used computer automation and the public Internet communication network to receive requests for service, selected an eligible provider from a collection of participating/approved providers, and scheduled the service, pickup and delivery of the car so that the concierge service is offered in a simple and automated fashion for the user.

4. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirke in view of Mulebach et al (Retaining tenants with the personal touch). Mulebach et al teaches techniques to retain real estate tenants. Mulebach et al teaches the offering of a concierge desk and a mobile car. It would have been obvious to one of ordinary skill at the time of the invention to have offered the benefits of Kirke's car repair pickup and delivery in order to keep tenants happy.

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5. Claims 7-11, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirke in view of Lambiase (Re: recent pricing on Civic EX coup). Lambiase teaches the UBS (United Buying Service) which helps users find and purchase cars. Lambiase teaches that such a service is offered by a company to their employees. It would have been obvious to one of ordinary skill at the time of the invention to have additionally offered such a car buying service with that of Kirke. This would provide additional morale, retention and recruitment benefits for the company. Official Notice is taken that UBS receives the client's car needs and helps locate and purchase it for them. It would have been obvious to one of ordinary skill at the time of the invention to have scheduled an appointment with eligible dealers so that the client can see and test drive the selected cars.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirke in view of Kuoch (Automatically schedule your car maintenance). Kuoch teaches a computer program that registers a user's car parameters and automatically notifies the user by email when service is due. It would have been obvious to one of ordinary skill at the time of the invention to have provided such an automated car repair maintenance service with the car concierge services of Kirke so that client's can automatically schedule maintenance visits.

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Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Derossi (Derossi, Luke, "PR: Magic & Tech announce car shopping svc," 1996/06/25, usenet posting to comp.os.magic-cap) teaches an Internet-based car shopping service for Tech Fed members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Av 3622